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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/044,484 | 01/11/2002 | Larry C. Frame | 020375-007400US | 9883 |
| 20350 | 7590 | 01/10/2005 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP | | | LE, DEBBIE M | |
| TWO EMBARCADERO CENTER | | | ART UNIT | |
| EIGHTH FLOOR | | | PAPER NUMBER | |
| SAN FRANCISCO, CA 94111-3834 | | | 2167 | |

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,484

Applicant(s)

FRAME ET AL.

Examiner

DEBBIE M LE

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicants' arguments filed on 7/28/04. Claims 1-24 are presented for examinations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Aiken (USP 6,658,626 B1).

As per claim 1, Aiken discloses a method for displaying results (outputs) of a comparison between two or more document comprising:

comparing data contained in a key segment (segments, e.g. paragraphs in a written report, method in a computer program, etc., col. 16, line 64-65) of each record of a first file (fig. 6, DOCUMENT A) to data in a related key segment of each record of a second file (fig. 6, DOCUMENT B);

upon each occurrence of a match (data related to any matches found) of data in the key segment of a record in the first file to data in the related key segment of a record in the second file (the results of comparing two or more documents for similar or matching passages, col. 2, lines 37-38), creating a record in a temporary electronic file, wherein the record in the temporary file includes data from the records of both the first and second files having matching key segment data (as the input for a step 402 is a list of matches that was created at step 114 of Fig. 1a (col. 11, lines 6-7) is stored in a temporary file (col. 7, lines 6-26));

selecting data from records of the temporary file and outputting the selected data (Fig. 6, col. 18, lines 3-18, col. 14, lines 50-53).

As per claim 2, Aiken teaches thereafter deleting the temporary file (reset the counter to zero, col. 7, lines 60-67, col. 8, lines 16-21).

As per claim 3, Aiken teaches for additional files (determined if there are any other documents, the next document is selected), repeating (the process is repeated) steps a), b) and c) using an additional file as the first file and the temporary file as the second file (col. 8, lines 24, lines 35-38).

As per claims 4-5, Aiken teaches wherein the first file is stored in electronic form on magnetic tape, media selected from a group consisting of solid state memory, magnetic disk memory, and optical memory (fig. 8, col. 20, lines 50-67).

As per claim 6, Aiken teaches sorting the records of the first file based on data contained in the key segment (list of pairs is sorted, col. 11, lines 47-67).

As per claim 7, Aiken teaches wherein a record of the temporary file created upon a match of data between records in the first and second files contains less than (now shorter) all of the data from the matching records of the first and second files (col. 14, lines 10-28, col. 15, lines 3-11).

As per claims 8-9, Aiken teaches selecting data from the records of the temporary file based in part on logic operators, wherein the logic operators are selected from a group consisting of less than, greater than, equal to, not-equal-to, less-than-or-equal-to, greater-than-or-equal-to, in and not in (equal to or less than or greater than, col. 7, lines 45-48, col. 13, line 57).

Claims 10, 18, and 24 are rejected by the same rationale as state in independent claim 1 arguments.

Claims 11-17, 19-23 have similar limitations as state in dependent claims 2-9; therefore, they are rejected under the same subject matter.

Response to Arguments

Applicant's arguments filed 7/28/04 have been fully considered but they are not persuasive.

Applicants argued that a temporary file disclosed by Aiken (US Patent 6,658,626 B1) does not store data from the records of both the first and second files having matching key segment data. The temporary file of Aiken stores position and hash value information.

In response, the examiner respectfully disagrees. The examiner submits that Aiken does teach at column 7, lines 6-10 that "At step 114, the program stores data relating to any matches found... in a temporary file." The temporary file of Aiken stores hash value and position data, wherein the position data contains the name of the document or **file** that is being hashed [see col. 8, lines 64-65]. It should be noted that the temporary file of Aiken stores data relating to any matches found (hash value and position data), and the position data contains the file as disclosed by Aiken is equivalent to the claim limitation 'the temporary file includes data from the records of both the first and second files having matching key segment data'. From the above passages, Aiken does indeed teach the claimed language 'the temporary file includes data from the records of both the first and second files having matching key segment data'.

Applicants argued that Aiken does not teach data is selected from the temporary file and output the selected data.

In response, the examiner respectfully disagrees. The examiner submits that Aiken teaches at column 18, lines 8-14 that "This allows the user to examine the overview bar for a document, select a sub-band, and bring up the content associated with the sub-band...clicking on sub-band 614B can also bring up the matching text segment ...in Document A as well as in Document B. In addition, Aiken discloses at column 14 lines 50-53 that "For those overlaps that have the same offset as overlaps in the 0 positions, the information stored in the temporary data structure is used to replace the overlapping P passages". Thus, Aiken does teach the claimed language "data is selected from the temporary file and output the selected data".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M LE whose telephone number is (571) 272-4111. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DEBBIE M LE
Examiner
Art Unit 2167

Debbie Le

Jan. 5, 2005.



GLORIA ROBINS
PRIMARY EXAMINER